UNITED STATES PATENT AND TRADEMARK OFFICE

TRADEMARK TRIAL AND APPEAL BOARD

PRAIRIE ISLAND INDIAN COMMUNITY, Petitioner, v. TREASURE ISLAND CORPORATION, Registrant.	Opposition No. 115,866 and Cancellation Nos. 28,126; 28,127; 28,130; 28,133; 28,145; 28,155; 28,199; 28,248; 28,280; 28,294; 28,314; 28,319; 28,325; 28,342; 28,379

REGISTRANT'S MOTION (1) TO DETERMINE SUFFICIENCY OF RESPONSES TO REQUESTS FOR ADMISSIONS; (2) TO COMPEL SUPPLEMENTAL RESPONSES TO INTERROGATORIES; AND (3) FOR PRODUCTION OF DOCUMENTS

Registrant Treasure Island Corporation ("TIC") hereby moves for an order (1) determining the sufficiency of the responses by Petitioner Prairie Island Indian Community ("Prairie Island") to TIC's Requests for Admission Nos. 5-7, 13, 15, 18, 21, 24, 27, 30-31 and 69, and compelling supplemental responses; and (2) compelling Petitioner to serve supplemental responses to TIC's Interrogatory Nos. 1, 5, 6(c), 6(f), 6(g) and 9 of Set No. 3. In addition, TIC moves to compel Prairie Island to produce documents responsive to TIC's Document Request No. 1 of Set No. 3.

TIC has made a good faith effort to resolve these discovery disputes but has been unable to obtain supplemental responses or documents from Prairie Island, as set forth in the accompanying Declaration of Michael J. McCue.

BACKGROUND

Petitioner Prairie Island is seeking to cancel 17 federal trademark registrations owned by TIC for marks containing the words "Treasure Island" on the grounds that Prairie Island has priority of use and the marks are likely to cause confusion. In order to discover

facts to support its claims and affirmative defenses, TIC served its Requests for Admissions (Set One) and Interrogatories (Set Three). Prairie Island served improper and incomplete responses, along with baseless objections in response to TIC's Requests for Admission Nos. 5-7, 13, 15, 18, 21, 24, 27, 30-31 and 69 and Interrogatory Nos. 1, 5, 6(c), 6(f), 6(g) and 9. In addition, Prairie Island has failed and refused to properly supplement its responses. Moreover, Prairie Island has failed to produce documents responsive to TIC's Document Request No. 1 of Set 3, despite its statement that it would do so and TIC's repeated requests.

Consequently, TIC requests that the Board order Prairie Island to serve supplemental responses to TIC's Interrogatory Nos. 1, 5, 6(c), 6(f), 6(g) and 9 of Set No. 3 and Requests for Admission Nos. 5-7, 13, 15, 18, 21, 24, 27, 30-31 and 69, as well as produce documents responsive to TIC's Document Request No. 1 of Set No. 3.

SUMMARY OF FACTS

A. Prairie Island Served Improper and Incomplete Responses and Baseless Objections to TIC's Requests for Admissions (Set One) and Interrogatories (Set Three)

On June 7, 2002, TIC served Prairie Island with its Requests for Admissions (Set One) and Interrogatories (Set Three). On July 12, 2002, Prairie Island served its responses to such discovery requests. See McCue Decl. Exhs. A (responses to requests for admissions) and B (interrogatory responses).

On August 2, 2002, TIC sent Prairie Island a meet and confer letter setting forth in detail reasons why Prairie Island's responses to requests for admissions nos. 5-7, 13, 15, 18, 21, 24, 27, 30-31 and 69 and responses to interrogatory nos. 1, 5, 6(c), 6(f) are improper and incomplete or contain baseless objections. See McCue Decl. Exh. C.

On August 13, 2002, Prairie Island sent TIC a written response to TIC's August 2, 2002 meet and confer letter. See McCue Decl. Exh. D.

On August 16, 2002, TIC sent Prairie Island another meet and confer letter attempting to resolve this discovery dispute, along with further explanation why Prairie Island's discovery responses must be amended and supplemented. See McCue Decl., Exh. E.

On September 6, 2002, Prairie Island sent TIC a written response to TIC's August 16, 2002 second meet and confer letter. See McCue Decl. Exh. F.

To date, Prairie Island has not provided supplemental responses to the disputed discovery requests.

B. Prairie Island has Failed to Produce Documents Responsive to TIC's Requests for Documents (Set 3)

On or about July 12, 2002, Prairie Island served its written responses to TIC's Requests for Production of Documents (Set 3). See McCue Decl. Exh. G. Although Prairie Island states that it will produce documents responsive to Request No. 1, to date, Prairie Island has not produced such documents. See McCue Decl. ¶ 8.

On July 25, 2002, TIC requested that Prairie Island produce all documents responsive to TIC's Document Request No. 1 of Set 3, which are printouts of Prairie Island's web site for its casino since the inception. See McCue Decl. Exh. H. On August 16, 2002, TIC reminded Prairie Island that it had not produced these documents. See McCue Decl., Exh. E.

On August 29, 2002, TIC again reminded Prairie Island that it still had not produced documents responsive to Document Request No. 1 of Set 3, which were necessary for the deposition of Jason Holt, one of Prairie Island's Rule 30(b)(6) designees. See McCue Decl. Exh. I.

On September 17, 2002, TIC sent Prairie Island another meet and confer letter regarding TIC's outstanding discovery requests, including Prairie Island's failure to produce

documents responsive to Document Request No. 1 of Set 3. See McCue Decl. Exh. J.

Prairie Island's counsel orally informed TIC that it would produce print outs of the web site. To date, Prairie Island has failed to produce print outs of the web site even though approximately ten weeks have passed since Prairie Island indicated that production of the print outs of the web sites would be made. McCue Decl. ¶ 13.

ARGUMENT

I. PRAIRIE ISLAND SHOULD BE COMPELLED TO ADMIT OR AMEND ITS RESPONSES TO TIC'S REQUESTS FOR ADMISSIONS NOS. 5-7, 13, 15, 18, 21, 24, 27, 30-31 and 69.

Pursuant to Fed. R. Civ. Proc. Rule 36(a), "[a] party may serve upon any other party a written request for the admission, for purposes of the pending action only, of the truth of any matters within the scope of Rule 26(b)(1) set forth in the request that relate to statements or opinions of fact or of the application of law to fact, including the genuineness of any documents described in the request." In addition, Rule 36 requires that the answering party comply with the following:

> If objection is made, the reasons therefor shall be stated. The answer shall specifically deny the matter or set forth in detail the reasons why the answering party cannot truthfully admit or deny the matter. A denial shall fairly meet the substance of the requested admission, and when good faith requires that a party qualify an answer or deny only a part of the matter of which an admission is requested, the party shall specify so much of it as is true and qualify or deny the remainder. An answering party may not give lack of information or knowledge as a reason for failure to admit or deny unless the party states that the party has made reasonable inquiry and that the information known or readily obtainable by the party is insufficient to enable the party to admit or deny . . . .

Fed. R. Civ. Proc. Rule 36.

In the instant case, Prairie Island has failed to comply with its discovery obligations as set forth in Rule 36. Instead, Prairie Island has artificially interpreted the requests in order to avoid admissions, has stated incomplete and improper responses, and has asserted baseless objections. Accordingly, TIC has filed the instant motion with the Board

to determine the sufficiency of Prairie Island's answers and objections to TIC's Requests for Admissions (Set One). See Fed. R. Civ. Proc. Rule 36; 37 C.F.R. 2.120(h); Volkswagenwerk Aktiengesellschaft v. Ridewell Corp., 188 U.S.P.Q. 690 (T.T.A.B. 1975); and Watercare Corp. v. Midwesco-Enterprise, Inc., 171 USPQ 696 (T.T.A.B. 1971); 37 CFR 2.120(e), and TBMP 523.01 ("If a propounding party is dissatisfied with a responding party's answer or objection to a request for admission, and wishes to obtain a ruling on the sufficiency thereof, the propounding party may file a motion with the Board to determine the sufficiency of the response").

Pursuant to Rule 36, unless the Board determines that an objection is justified, it shall order that an answer be served. See Fed. R. Civ. Proc. 36. Furthermore, if the Board "determines that an answer does not comply with the requirements of this rule, it may order either that the matter is admitted or that an amended answer be served." See id.

Based on the following, TIC requests a Board determination that Prairie Island's responses and objections to TIC's Requests for Admission Nos. 5-7, 13, 15, 18, 21, 24, 27, 30-31 and 69 are improper and an Order that the requests be admitted or amended answers be served.

A. The Board Should Order Prairie Island to Serve Admit or Amend its Responses to Requests for Admission Nos. 5, 6 & 7

Request for Admission No. 5:

Admit that at the time You began using the "Treasure Island" mark, alone or with other words, a third party owned a federal trademark registration for "Treasure Island Hotel & Casino St. Maarten, N.A." (with "hotel & casino" and "St. Maarten, N.A." disclaimed) for casino services.

Prairie Island's Response[1]

The Community objects to and can neither admit nor deny this Request because it fails to identify the time period for which it seeks an admission of knowledge with regard to the existence of the Saint Maarten mark.

Basis for Compelling Amended Response

Prairie Island's objection that TIC fails to identify the time period for which it seeks an admission is incorrect. The Request clearly sets forth a time period: "at the time [Prairie Island] began using the "Treasure Island" mark, alone or with other word." Prairie Island certainly knows when it started using the TREASURE ISLAND mark, especially when the basis of its claims in these proceedings is priority of use for the TREASURE ISLAND mark. Accordingly, Prairie Island's objection lacks merit.

Prairie Island initially objected to the Request on the basis that it did not specify a time period. However, after TIC explained that indeed the Request contains a relevant time period, Prairie Island asserted another baseless (and untimely) objection, namely that Prairie Island does not know what "ownership" means. Furthermore, Prairie Island makes the specious claim that it was not aware of the St. Maarten mark, despite the fact that letters from Prairie Island's attorneys which have been disclosed in this litigation clearly reveal that Prairie Island was not only aware of such mark but that it prevented Prairie Island from seeking a federal registration. Undoubtedly, Prairie Island has sufficient information and knowledge to admit or deny Request No. 5.

Request for Admission No. 6:

Admit that Treasure Island N.V.'s 1987 registration for "Treasure Island Hotel & Casino St. Maarten, N.A." was one of the reasons You did not seek registration of the word

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[1] Prairie Island's attorneys subsequently asserted various other reasons for Prairie Island's failure to admit the facts set forth in Request No. 5. See McCue Exhs. D & F.

mark "Treasure Island" for casino services until October 1997.

Prairie Island's Response

Deny. See Answer to Interrogatory No. 6(b).

Basis for Compelling Amended Response

Prairie Island denied Request No. 6 based on its contention that its "sought registration of the word mark TREASURE ISLAND in 1992 with the State of Minnesota and in 1993 with the State of Wisconsin, and marks including the words TREASURE ISLAND in Minnesota, Wisconsin, North Dakota, South Dakota, Iowa and Illinois in 1993."

The denial is improper because Prairie Island intentionally misinterpreted Request No. 6 to avoid an admission. There is no dispute that Prairie Island did not file an application for a federal trademark registration of any mark containing the words TREASURE ISLAND until October 1997. Thus, Prairie Island knows that this request refers to Prairie Island's failure to seek federal registration of TREASURE ISLAND until 1997. The request is nonsensical if construed to refer to state trademark registrations, because Prairie Island applied for state trademark registrations prior to October 1997. Rule 36 requires that "[a] denial shall fairly meet the substance of the requested admission, and when good faith requires that a party qualify an answer or deny only a part of the matter of which an admission is requested, the party shall specify so much of it as is true and qualify or deny the remainder." By answering this request as though it applied to state rather than federal trademark applications, Prairie Island has failed to fairly meet the substance of the request for admission. Prairie Island's lack of good faith in responding to the request is further demonstrated by the fact that it refused to provide a supplemental response after TIC explained to Prairie Island how Request No. 6 necessarily refers to federal trademark registration.

Request for Admission No. 7:

Admit that Your use of "Treasure Island" for casino services infringed the "Treasure Island Hotel & Casino St. Maarten, N.A." mark for casino services.

Prairie Island's Response

Deny. See Answer to Interrogatory No. 9.

Basis for Compelling Amended Response

Prairie Island's denial of Request No. 7, which incorporates its response to Interrogatory No. 9, is based on improper objections.[2] Fed. R. Civ. Proc. Rule 36 allows a party to serve a written request for the admission of the truth of any matter that relates to "statements or opinions of fact or of the application of law to fact."

The Request is simple and straight forward. Prairie Island's objection to TIC's use of the term "infringed" is misguided given Prairie Island's claims in these proceedings and obvious understanding of that term. Moreover, Prairie Island's objections that the request calls for speculation or a legal confusion are improper. See Fed. R. Civ. Proc. Rule 36. Furthermore, whether or not Treasure Island N.V. lodged a claim of infringement against Prairie Island or whether there has been a legal determination of infringement, is irrelevant to the issue of whether Prairie Island's use of TREASURE ISLAND was infringing.

B. The Board Should Order Prairie Island to Admit Request for Admission No. 13.

Request for Admission No. 13:

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[2] Prairie Island's response to Interrogatory No. 9 states:

> The community objects to this Interrogatory because it is vague and ambiguous in its use of the undefined term "infringe", because it calls for the Community to speculate and because it calls for the Community to state facts based on a legal conclusion. Subject to and without waiving these objections, the Saint Maarten concern lodged no claim of infringement against the Community and there has been no determination that the Community's use of the mark TREASURE ISLAND infringed on the Saint Maarten mark. See McCue Decl. Exhs. D & F.

Admit that, in 1992, You first learned of Registrant's plans to use a trademark containing the words "Treasure Island", alone or with other words, for its hotel and casino.

Prairie Island's Response

The Community objects to this Request because it employs the term trademark, which attempts to impute to the Community sophistication in intellectual property matters. Subject to and without waiving this objection, Deny. See Answer to Interrogatory No. 6(e).

Basis for Compelling Amended Response

Prairie Island's objection to TIC's use of the term "trademark" is baseless given Prairie Island's prior and repeated use of the term itself. Such gamesmanship should not be condoned by the Board. In addition, Prairie Island's denial of the request is inconsistent with its answer to Interrogatory No. 6(e) referenced in its response to Request No. 13. In response to Interrogatory No. 6(e), Prairie Island states that "the Community previously has stated in response to discovery requests and in sworn deposition testimony that when (sic) in **1992** it first became aware that there was a casino facility under construction on the Las Vegas Strip that was to be named Treasure Island" (emphasis added). Accordingly, Prairie Island must admit this Request.

C. The Board Should Order Prairie Island to Admit Requests for Admission Nos. 15, 18, 21, 24 and 27[3]

Request for Admission Nos. 15, 18, 21, 24 and 27:

No. 15: Admit that, in 1992, you never notified, in writing or verbally, Registrant (or any affiliated corporation) of your claim to superior rights in or prior use of the words "Treasure Island" alone or with other words.

No. 18: Admit that, in 1993, you never notified, in writing or verbally, Registrant's

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[3] In the alternative, the Board should order Prairie Island to explain the circumstances (including when, how, who, and to whom) Prairie Island provided written or oral notice to TIC that it claimed superior rights in or prior use of the Treasure Island mark, without Prairie Island's self-serving and misplaced comments regarding its alleged "constructive notice" to TIC.

(or any affiliated corporation) of your claim to superior rights in or prior use of the words "Treasure Island" alone or with other words.

No. 21: Admit that, in 1994, you never notified, in writing or verbally, Registrant (or any affiliated corporation) of your claim to superior rights in or prior use of the words "Treasure Island" alone or with other words.

No. 24: Admit that, in 1995, you never notified, in writing or verbally, Registrant (or any affiliated corporation) of your claim to superior rights in or prior use of the words "Treasure Island" alone or with other words.

No. 27: Admit that, in 1996, you never notified, in writing or verbally, Registrant (or any affiliated corporation) of your claim to superior rights in or prior use of the words "Treasure Island" alone or with other words.

Prairie Island's Response

No. 15: Deny. See Answer to Interrogatory No. 6(g).

No. 18: Deny. See Response to Request No. 15 and Answer to Interrogatory No. 6(g).

No. 21: Deny. See Response to Request No. 15 and Answer to Interrogatory No. 6(g).

No. 24: Deny. See Response to Request No. 15 and Answer to Interrogatory No. 6(g).

No. 27: Deny. See Response to Request No. 15 and Answer to Interrogatory No. 6(g).

Basis for Compelling Admission or Amended Response

Prairie Island's responses to these requests are non-responsive and based on an improper and artificial interpretation of the Requests. The requests are simple and straight forward in requesting that Prairie Island "admit that, in 1992 [and for each year 1993, 1994, 1995 & 1996], you never notified, **in writing or verbally**, Registrant (or any affiliated corporation) or your claim to superior rights in or prior use of the words 'Treasure Island' alone or with other words" (emphasis added). The term "notified" clearly does not mean constructive notice and specifically refers to written or verbal notice. Moreover, Prairie

Island's self-serving commentary on its belief that it provided TIC with constructive notice of its claim to superior rights is non-responsive and an obvious attempt to avoid an admission.

Prairie Island's tactics have already been rejected by the Board in its April 17, 2001 ruling when Prairie Island previously tried to equate "constructive notice" with actual notice in order to hide the fact that it (1) knew about TIC's adoption, use and registration of marks containing the word TREASURE ISLAND for six or more years; (2) stood idly by as TIC invested hundreds of millions of dollars in building the hotel/casino and developing goodwill in the marks; and (3) never claimed rights in the TREASURE ISLAND marks until initiating this cancellation proceeding. See Board's Order dated April 17, 2001. [4] TIC's Request Nos. 15, 18, 21, 24 and 27 are even more specific that the prior interrogatories because they specifically related to written or oral notice. Therefore, Prairie Island's denials are improper if they are based on its "constructive notice" theory, which involves neither actual written or oral notice.

D. The Board Should Order Prairie Island to Admit or Deny Request for Admission No. 69.

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[4] The Board's April 17, 2001 ruling resulted from TIC's Motion to Compel filed September 1, 1999. TIC's Interrogatory Nos. 13 and 14 (Set 2) asked Prairie Island to state when it notified TIC (or any affiliated or related corporation) of its claim to superior rights in or prior use of the mark TREASURE ISLAND and if the earliest date was earlier than October 1993, to give the reasons why it waited to notify TIC that TIC's mark was likely to cause confusion. Registrant, with regard to the existence of Petitioner and Petitioner's TREASURE ISLAND mark." See McCue Exh.K. (Prairie Island's Answers and Objections to the Registrants Second Set of Interrogatories. Prairie Island continued to stand by its responses and refused to provide supplemental responses. See pertinent page of Petitioner's Response to Registrant's Motion to Compel (McCue Exh. L). The Board rejected Prairie Island's arguments and stated:

> Petitioner's response did not answer [the questions]. Petitioner is ordered to state whether it notified respondent of its claim, and if so, when such notification took place. Further, if petitioner claims that it notified respondent of its claim later than October 1993, petitioner must state why it waited until then to do so. This information would clearly relate to respondent's pleaded defense of laches.

See April 17, 2001 Order (McCue Decl., Exh. K at page 4).

Prairie Island's Response[1]

The Community objects to and can neither admit nor deny this Request because it fails to identify the time period for which it seeks an admission of knowledge with regard to the existence of the Saint Maarten mark.

Basis for Compelling Amended Response

Prairie Island's objection that TIC fails to identify the time period for which it seeks an admission is incorrect. The Request clearly sets forth a time period: "at the time [Prairie Island] began using the "Treasure Island" mark, alone or with other word." Prairie Island certainly knows when it started using the TREASURE ISLAND mark, especially when the basis of its claims in these proceedings is priority of use for the TREASURE ISLAND mark. Accordingly, Prairie Island's objection lacks merit.

Prairie Island initially objected to the Request on the basis that it did not specify a time period. However, after TIC explained that indeed the Request contains a relevant time period, Prairie Island asserted another baseless (and untimely) objection, namely that Prairie Island does not know what "ownership" means. Furthermore, Prairie Island makes the specious claim that it was not aware of the St. Maarten mark, despite the fact that letters from Prairie Island's attorneys which have been disclosed in this litigation clearly reveal that Prairie Island was not only aware of such mark but that it prevented Prairie Island from seeking a federal registration. Undoubtedly, Prairie Island has sufficient information and knowledge to admit or deny Request No. 5.

Request for Admission No. 6:

Admit that Treasure Island N.V.'s 1987 registration for "Treasure Island Hotel & Casino St. Maarten, N.A." was one of the reasons You did not seek registration of the word

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[1] Prairie Island's attorneys subsequently asserted various other reasons for Prairie Island's failure to admit the facts set forth in Request No. 5. See McCue Exhs. D & F.

mark "Treasure Island" for casino services until October 1997.

Prairie Island's Response

Deny. See Answer to Interrogatory No. 6(b).

Basis for Compelling Amended Response

Prairie Island denied Request No. 6 based on its contention that its "sought registration of the word mark TREASURE ISLAND in 1992 with the State of Minnesota and in 1993 with the State of Wisconsin, and marks including the words TREASURE ISLAND in Minnesota, Wisconsin, North Dakota, South Dakota, Iowa and Illinois in 1993."

The denial is improper because Prairie Island intentionally misinterpreted Request No. 6 to avoid an admission. There is no dispute that Prairie Island did not file an application for a federal trademark registration of any mark containing the words TREASURE ISLAND until October 1997. Thus, Prairie Island knows that this request refers to Prairie Island's failure to seek federal registration of TREASURE ISLAND until 1997. The request is nonsensical if construed to refer to state trademark registrations, because Prairie Island applied for state trademark registrations prior to October 1997. Rule 36 requires that "[a] denial shall fairly meet the substance of the requested admission, and when good faith requires that a party qualify an answer or deny only a part of the matter of which an admission is requested, the party shall specify so much of it as is true and qualify or deny the remainder." By answering this request as though it applied to state rather than federal trademark applications, Prairie Island has failed to fairly meet the substance of the request for admission. Prairie Island's lack of good faith in responding to the request is further demonstrated by the fact that it refused to provide a supplemental response after TIC explained to Prairie Island how Request No. 6 necessarily refers to federal trademark registration.

Request for Admission No. 7:

Admit that Your use of "Treasure Island" for casino services infringed the "Treasure Island Hotel & Casino St. Maarten, N.A." mark for casino services.

Prairie Island's Response

Deny. See Answer to Interrogatory No. 9.

Basis for Compelling Amended Response

Prairie Island's denial of Request No. 7, which incorporates its response to Interrogatory No. 9, is based on improper objections.[2] Fed. R. Civ. Proc. Rule 36 allows a party to serve a written request for the admission of the truth of any matter that relates to "statements or opinions of fact or of the application of law to fact."

The Request is simple and straight forward. Prairie Island's objection to TIC's use of the term "infringed" is misguided given Prairie Island's claims in these proceedings and obvious understanding of that term. Moreover, Prairie Island's objections that the request calls for speculation or a legal confusion are improper. See Fed. R. Civ. Proc. Rule 36. Furthermore, whether or not Treasure Island N.V lodged a claim of infringement against Prairie Island or whether there has been a legal determination of infringement, is irrelevant to the issue of whether Prairie Island's use of TREASURE ISLAND was infringing.

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[2] Prairie Island's response to Interrogatory No. 9 states:

> The community objects to this Interrogatory because it is vague and ambiguous in its use of the undefined term "infringe", because it calls for the Community to speculate and because it calls for the Community to state facts based on a legal conclusion. Subject to and without waiving these objections, the Saint Maarten concern lodged no claim of infringement against the Community and there has been no determination that the Community's use of the mark TREASURE ISLAND infringed on the Saint Maarten mark. See McCue Decl. Exhs. D & F.

B. The Board Should Order Prairie Island to Admit Request for Admission No. 13.

Request for Admission No. 13:

Admit that, in 1992, You first learned of Registrant's plans to use a trademark containing the words "Treasure Island", alone or with other words, for its hotel and casino.

Prairie Island's Response

The Community objects to this Request because it employs the term trademark, which attempts to impute to the Community sophistication in intellectual property matters. Subject to and without waiving this objection, Deny. See Answer to Interrogatory No. 6(e).

Basis for Compelling Amended Response

Prairie Island's objection to TIC's use of the term "trademark" is baseless given Prairie Island's prior and repeated use of the term itself. Such gamesmanship should not be condoned by the Board. In addition, Prairie Island's denial of the request is inconsistent with its answer to Interrogatory No. 6(e) referenced in its response to Request No. 13. In response to Interrogatory No. 6(e), Prairie Island states that "the Community previously has stated in response to discovery requests and in sworn deposition testimony that when [sic] in **1992** it first became aware that there was a casino facility under construction on the Las Vegas Strip that was to be named Treasure Island" (emphasis added). Accordingly, Prairie Island must admit this Request.

C. The Board Should Order Prairie Island to Admit Requests for Admission Nos. 15, 18, 21, 24 and 27[3]

Request for Admission Nos. 15, 18, 21, 24 and 27:

No. 15: Admit that, in 1992, you never notified, in writing or verbally, Registrant

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[3] In the alternative, the Board should order Prairie Island to explain the circumstances (including when, how, who, and to whom) Prairie Island provided written or oral notice to TIC that it claimed superior rights in or prior use of the Treasure Island mark, without Prairie Island's self-serving and misplaced comments regarding its alleged "constructive notice" to TIC.

(or any affiliated corporation) of your claim to superior rights in or prior use of the words "Treasure Island" alone or with other words.

No. 18: Admit that, in 1993, you never notified, in writing or verbally, Registrant's (or any affiliated corporation) of your claim to superior rights in or prior use of the words "Treasure Island" alone or with other words.

No. 21: Admit that, in 1994, you never notified, in writing or verbally, Registrant (or any affiliated corporation) of your claim to superior rights in or prior use of the words "Treasure Island" alone or with other words.

No. 24: Admit that, in 1995, you never notified, in writing or verbally, Registrant (or any affiliated corporation) of your claim to superior rights in or prior use of the words "Treasure Island" alone or with other words.

No. 27: Admit that, in 1996, you never notified, in writing or verbally, Registrant (or any affiliated corporation) of your claim to superior rights in or prior use of the words "Treasure Island" alone or with other words.

Prairie Island's Response

No. 15: Deny. See Answer to Interrogatory No. 6(g).

No. 18: Deny. See Response to Request No. 15 and Answer to Interrogatory No. 6(g).

No. 21: Deny. See Response to Request No. 15 and Answer to Interrogatory No. 6(g).

No. 24: Deny. See Response to Request No. 15 and Answer to Interrogatory No. 6(g).

No. 27: Deny. See Response to Request No. 15 and Answer to Interrogatory No. 6(g).

Basis for Compelling Admission or Amended Response

Prairie Island's responses to these requests are non-responsive and based on an improper and artificial interpretation of the Requests. The requests are simple and straight forward in requesting that Prairie Island "admit that, in 1992 [and for each year 1993, 1994, 1995 & 1996], you never notified, **in writing or verbally**, Registrant (or any affiliated

corporation) or your claim to superior rights in or prior use of the words 'Treasure Island' alone or with other words" (emphasis added). The term "notified" clearly does not mean constructive notice and specifically refers to written or verbal notice. Moreover, Prairie Island's self-serving commentary on its belief that it provided TIC with constructive notice of its claim to superior rights is non-responsive and an obvious attempt to avoid an admission.

Prairie Island's tactics have already been rejected by the Board in its April 17, 2001 ruling when Prairie Island previously tried to equate "constructive notice" with actual notice in order to hide the fact that it (1) knew about TIC's adoption, use and registration of marks containing the word TREASURE ISLAND for six or more years; (2) stood idly by as TIC invested hundreds of millions of dollars in building the hotel/casino and developing goodwill in the marks; and (3) never claimed rights in the TREASURE ISLAND marks until initiating this cancellation proceeding. See Board's Order dated April 17, 2001.[4] TIC's Request Nos. 15, 18, 21, 24 and 27 are even more specific than the prior interrogatories because they specifically related to written or oral notice. Therefore, Prairie Island's denials are improper if they are based on its "constructive notice" theory, which involves

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[4] The Board's April 17, 2001 ruling resulted from TIC's Motion to Compel filed September 1, 1999. TIC's Interrogatory Nos. 13 and 14 (Set 2) asked Prairie Island to state when it notified TIC (or any affiliated or related corporation) of its claim to superior rights in or prior use of the mark TREASURE ISLAND and if the earliest date was earlier than October 1993, to give the reasons why it waited to notify TIC that TIC's mark was likely to cause confusion. Registrant, with regard to the existence of Petitioner and Petitioner's TREASURE ISLAND mark." See McCue Exh.K. (Prairie Island's Answers and Objections to the Registrants Second Set of Interrogatories. Prairie Island continued to stand by its responses and refused to provide supplemental responses. See pertinent page of Petitioner's Response to Registrant's Motion to Compel (McCue Exh. L). The Board rejected Prairie Island's arguments and stated:

> Petitioner's response did not answer [the questions]. Petitioner is ordered to state whether it notified respondent of its claim, and if so, when such notification took place. Further, if petitioner claims that it notified respondent of its claim later than October 1993, petitioner must state why it waited until then to do so. This information would clearly relate to respondent's pleaded defense of laches.

See April 17, 2001 Order (McCue Decl., Exh. K at page 4).

neither actual written or oral notice.

D. The Board Should Order Prairie Island to Admit or Deny Request for Admission No. 69.

Request for Admission No. 69:

Admit that "The Mirage" is a famous resort hotel casino located in Las Vegas, Nevada.

Prairie Island's Response

The request calls for an opinion and so is not subject to an admission or denial.

Basis for Compelling Amended Response

Prairie Island's objection that the request calls for an "opinion" is improper. Fed. R. Civ. Proc. Rule 36 allows a party to serve a written request for the admission of the truth of any matters that relates to "statements or opinions of fact or of the application of law to fact." In addition, a party cannot refuse to answer the request on the basis that the request presents a genuine issue for trial or because it may be required to rely on its own opinion. Accordingly, Prairie Island must either admit or deny Request No. 69.

II PRAIRIE ISLAND SHOULD BE COMPELLED TO PROVIDE COMPLETE RESPONSES TO INTERROGATORY NOS. 1, 5, 6(c), 6(f), 6(g) AND 9

A. The Board Should Order Prairie Island to Identify the Specific Attorneys Referenced in its Response to Interrogatory No. 1.

Interrogatory No. 1:

State all of your actions with regard to the "Treasure Island" mark which may disprove any claim of undue delay, as stated in your response to Interrogatory No. 21 of Registrant's Third[5] Set of Interrogatories.[6]

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[5] Interrogatory No. 21 was actually included in Set No. 2, not Set No. 3.

[6] Interrogatory No. 21 states: "If you contend that your claims for cancellation are not barred by the doctrine of laches, state in detail the facts and legal basis for your contention." Prairie Island responded as follows: "The answer asserts defenses not facts to support its laches defense."

Prairie Island's Response:

The Community previously has stated in response to discovery requests and in sworn deposition testimony that when in 1992 it first became aware of that there was a casino facility under construction on the Las Vegas Strip that was to be named Treasure Island, it directed its attorneys to contact the Registrant or its representatives regarding the Treasure Island Las Vegas Project (See, Deposition of Freeman Johnson). The Community also retained the intellectual property law firm of Merchant & Gould to advise it regarding its intellectual property concerns. The Community's intellectual property law firm undertook a watching service to monitor any attempt by the Las Vegas concern to acquire federal trademark registrations for marks containing the words Treasure Island. The Community's intellectual property law firm undertook a watching service to monitor the status of the federal registration for the mark Treasure Island held by an entity on the Island of Saint Maarten.

In July of 1992, the Community secured a Minnesota trademark registration for the word mark TREASURE ISLAND for use on and in connection with casino services and on December 8, 1993 secured a Wisconsin trademark registration for the word mark TREASURE ISLAND for use on and in connection with casino services. Also in December of 1993, the Community secured trademark registrations for its marks containing in whole or in part the words TREASURE ISLAND in the states of North Dakota, South Dakota, Iowa, Wisconsin and Illinois.

Upon learning that its intellectual property counsel had failed to advise it that the Saint Maarten mark had lapsed and that the Las Vegas concern had improperly secured several trademark registrations containing the words Treasure Island, the Community prepared for and within 12 months filed petitions to cancel those registrations.

Basis for Compelling Amended Response

Prairie Island's response to Interrogatory No. 1 is incomplete. Although Prairie Island alleges it directed certain "attorneys" and "intellectual property counsel" to act on its behalf, Prairie Island does not identify those attorneys, nor who from Prairie Island gave such direction. In addition, Prairie Island does not provide dates for its or its attorneys' alleged action.

B. The Board Should Order Prairie Island to Amend its Response to Interrogatory No. 5 to Allege Sufficient Facts and Legal Basis for its Contention

Interrogatory No. 5:

b) If you contend that the use of the "Treasure Island" mark since 1989 by Registrant's predecessor-in-interest, Golden Nugget, does not inure to the benefit of Registrant, state all facts and legal basis which support your contention.

Prairie Island's Response

b) The Community objects to this Interrogatory subpart because it is vague in its use of the phrase "inure to the benefit of Registrant". It is the Community's understanding that the Registrant purchased the TREASURE ISLAND mark from GNLV and assumes that, as a result of the purchase, the Registrant acquired all rights to that mark. The Community, however, does contend that the GNLV Slot Machine Merchandising mark purchased by the Registrant may not be used by the Registrant to tack to an earlier first date of first use for the marks that are the subject of these proceedings.

Basis for Compelling Amended Response

Prairie Island's answer is non-responsive because it merely asserts a legal conclusion without any factual basis as requested. Prairie Island must provide specific facts to support its contention that "the GNLV Slot Machine Merchandising mark purchased by the Registrant may not be used by the Registrant to tack to an earlier first date of first use for the marks that are the subject of these proceedings."

C. Prairie Island has Failed to Allege Sufficient Facts in its Responses to Interrogatory Nos. 6(c), 6(f) and 6(g)[7]

Interrogatory No. 6(f):[8]

If you responded with a denial to any of the requests in Registrant's First Set of Requests for Admissions, identify all facts that form the basis for each denial.

Prairie Island's Response

(f) The Community previously has stated in response to discovery requests and in sworn deposition testimony that when in 1992 it first became aware that there was a casino facility under construction on the Las Vegas Strip that was to be named Treasure Island, it directed its attorneys to contact the Registrant or its representatives regarding the Treasure Island Las Vegas Project (See, Deposition of Freeman Johnson). The Community also retained the intellectual property law firm of Merchant & Gould to advise it regarding its intellectual property concerns. The Community's intellectual property law firm undertook a watching service to monitor any attempt by the Las Vegas concern to acquire federal trademark registrations for marks containing the words Treasure Island. The Community's intellectual property law firm undertook a watching service to monitor the status of the federal registration for the mark Treasure Island held by an entity on the Island of Saint Maarten.

In July of 1992, the Community secured a Minnesota trademark registration for the word mark TREASURE ISLAND for use on and in connection with casino services and on December 8, 1993 secured a Wisconsin trademark registration for the word mark

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[7] In the Alternative, the Board should order Prairie Island to admit Requests for Admission Nos. 8, 13-15, 17-18, 20-21, 23-24, and 26-27.

[8] Prairie Island denied that it took no action in 1992, 1993, 1994, 1995 and 1996 to stop TIC's use of the TREASURE ISLAND mark, and provided Response 6(f) to support its denials. See Prairie Island's Responses to Requests for Admission Nos. 14, 17, 20, 23 and 26 (McCue Decl. Exh. A).

TREASURE ISLAND for use on and in connection with casino services. Also in December of 1993, the Community secured trademark registrations for its marks containing in whole or in part the words TREASURE ISLAND in the states of Minnesota, Wisconsin, North Dakota, South Dakota, Iowa and Illinois.

Upon learning in late 1996 that its intellectual property counsel had failed to advise it that the Saint Maarten mark had lapsed or that the Las Vegas concern had improperly secured several trademark registrations containing the words Treasure Island, the Community promptly prepared for and filed petitions to cancel those registrations.

Basis for Compelling Amended Response

Although Prairie Island alleges it directed certain "attorneys" and "intellectual property counsel" to act on its behalf, Prairie Island does not identify those attorneys, nor who from Prairie Island gave such direction. In addition, Prairie Island does not provide dates for its or its attorneys' alleged action.

Interrogatory No. 6(g)[9]:

If you responded with a denial to any of the requests in Registrant's First Set of Requests for Admissions, identify all facts that form the basis for each denial.

Prairie Island's Response

The Petitioner previously has provided discovery responses that address notice provided to TIC. The Community previously has objected to the vague use of the term "notified", specifically whether the term means actions taken by the Petitioner that provided TIC constructive notice, actions taken by the Petitioner that provided, or in the exercise of reasonable diligence by TIC, would have provided TIC with actual notice, or actions taken by the Petitioner to notify TIC by direct communication with TIC or its officers, employees,

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[9] In response to Interrogatory No. 6(c), Prairie Island states "See Response to Request for Admission No. 15 and Answer to Interrogatory 6(g)."

agents or representatives regarding the Petitioner's rights in the mark TREASURE ISLAND. The Community also has previously objected to the use of the term "notified" to the extent it asks the Community to provide a legal conclusion as to what conduct constitutes "notification", and to the use of the phrase "affiliated or related corporation", since neither that phrase, nor any of its component terms, are defined. Finally, the Community previously has objected to the request to the extent it asks the Petitioner to assume the legal conclusion that notification to an undefined "affiliated or related corporation" would constitute notification to the Registrant.

Subject to and without waiving these objections, and interpreting the ambiguous Request to seek an admission regarding actions taken by the Community that provided TIC with constructive notice of the Community's rights to the mark TREASURE ISLAND, the Community provided notice at least as early as January 1990, when it first began its public use of the name Treasure Island on and in connection with casino services, and no later than July 22, 1992 when the Community secured its first registration of the TREASURE ISLAND mark for use on and in connection with casino services, identify a first date of use of January 1990.

Subject to and without waiving these objections, and interpreting the ambiguous Request to seek an admission regarding actions taken by the Community that provided TIC with actual notice of the Community's rights, at least as early as October 21, 1991 when Edward Quirk reported the results of a Thomson & Thomson search result to Mr. Bruce Levin, which report disclosed the Petitioner's prior, continuing and conflicting use of the mark TREASURE ISLAND, and no later than March 1993 when Edward Quirk reported the results of a Thomson & Thomson search result to Mr. Bruce Levin, which report disclosed the Petitioner's prior, continuing and conflicting use of the mark TREASURE ISLAND and its registration of that mark, which identified a first date of use of January 1990, the first of

which actions occurred before construction of the Treasure Island facility in Las Vegas and before any meaningful action had been taken to plan, design or theme the facility and the latter of which occurred before construction of the Treasure Island facility was completed and over a half year prior to the opening of that facility to the public.

Subject to and without waiving these objections, and interpreting the ambiguous Request to seek and admission regarding actions taken by the Petitioner to communicate directly with the Registrant regarding the Petitioner's rights in the mark TREASURE ISLAND, based on the record developed to date in this case, as early as late 1992, when the Tribal Council directed its attorneys to contact the Registrant or its representatives regarding the Treasure Island Las Vegas Project (See, Deposition of Freeman Johnson), and no later than October 28, 1998, when the Petitioner filed its first of 17 Petitions to Cancel federal service mark registrations improperly obtained by the Registrant.

Basis for Compelling Amended Response

Prairie Island denied that it never notified TIC in writing or verbally of its purported claim to superior rights in or prior use of the TREASURE ISLAND mark, and provided response 6(g) to support its denials. See Prairie Island Response to Requests for Admissions Nos. 15, 18, 21, 24 and 27. However, Response 6(g) does not support such denials.

As discussed above Prairie Island's responses are non-responsive and based on an improper and artificial interpretation of the Requests for Admission. The Requests are simple and straight forward in requesting that Prairie Island "admit that, in 1992 [and for each year 1993, 1994, 1995 & 1996], you never notified, **in writing or verbally**, Registrant (or any affiliated corporation) or your claim to superior rights in or prior use of the words 'Treasure Island' alone or with other words" (emphasis added). The term "notified" clearly does not mean constructive notice and specifically refers to written or verbal notice.

Moreover, Prairie Island's self-serving commentary on its belief that it provided TIC with constructive notice of its claim to superior rights is non-responsive and an obvious attempt to avoid an admission. Moreover, Prairie Island's tactics have already been rejected by the Board in its April 17, 2001 ruling when Prairie Island previously tried to equate "constructive notice" with actual notice.

D. Prairie Island has Failed to Allege Sufficient Facts in its Responses to Interrogatory No. 9

Interrogatory No. 9:

If you contend that Your use of marks containing "Treasure Island" for casino services did not infringe the mark "Treasure Island Hotel & Casino St. Maarten, N.A." for casino services, set forth each and every fact supporting Your contention.

Prairie Island's Response

The Community objects to this Interrogatory because it is vague and ambiguous in its use of the undefined term "infringe", because it calls for the Community to speculate and because it calls for the Community to state facts based on a legal conclusion. Subject to and without waiving these objections, the Saint Maarten concern lodged no claim of infringement against the Community and there has been no determination that the Community's use of the mark TREASURE ISLAND infringed on the Saint Maarten mark.

Basis for Compelling Amended Response

Prairie Island's response is based on improper objections and is non-responsive. The Request is simple and straight forward. In addition, Fed. R. Civ. Proc. Rule 36 allows a party to serve a written request for the admission of the truth of any matter that relates to "statements or opinions of fact or of the application of law to fact." Moreover, Prairie Island's objection to TIC's use of the term "infringed" is misguided given Prairie Island's claims in these proceedings. Furthermore, Prairie Island's objections that the interrogatory

calls for speculation or a legal confusion are improper. Whether or not Treasure Island N.V. lodged a claim of infringement against Prairie Island or whether there has been a legal determination of infringement is irrelevant. If Prairie Island contends that its use of marks containing "Treasure Island" for casino services did not infringe the mark "Treasure Island Hotel & Casino St. Maarten, N.A." for casino services, then it must state all facts to support such contention.

III. THE BOARD SHOULD COMPEL PRAIRIE ISLAND TO PRODUCE DOCUMENTS RESPONSIVE TO DOCUMENT REQUEST NO. 1 OF SET 3.

On or about July 12, 2002, Prairie Island served its written responses to TIC's Requests for Production of Documents (Set 3) stating that it would produce responsive documents. McCue Decl. Exh. G. However, despite repeated requests, to date, Prairie Island has produced no such documents. McCue Decl. ¶ 8. Consequently, TIC seeks an Order from the Board compelling Prairie Island to produce all documents responsive to TIC's Document Request No. 1 of Set 3.

CONCLUSION

The Board should grant TIC's motion to compel.

DATED: September 30, 2002

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CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing document was served this 30th day of September, 2002, by first class mail, postage prepaid, to Petitioner'scounsel of record, as follows:

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CERTIFICATE OF SERVICE

I, Carlene M. Arnold, do hereby certify that this document is being deposited with the United States Postal Service as Express Mail, postage prepaid, in an envelope addressed to the Assistant Commissioner for Trademarks, BOX TTAB, 2900 Crystal Drive, Arlington, Virginia 22202-3513, on the date below.

Carlene M. Arnold
An Employee of Quirk & Tratos

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September 30, 2002
Date of Deposit